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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
EHCD3-16715/CPA2

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on 09-04-2009

Signature

Typed or printed name STEPHANIE DENT

Application Number	Filed
08/902692	07-30-1997

First Named Inventor
WILLIAM J. REA

Art Unit	Examiner
1644	SCHWADRON, RONALD

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 36,426
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Signature

TODD E. ALBANESI
Typed or printed name

214-220-0444
Telephone number

09-04-2009
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☑ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:	William J. Rea and Bertie B. Griffiths	Attorney Docket:	EHCD3-16715/CPA2
Serial No.	08/902,692	Art Unit:	1644
Filed:	July 30, 1997	Examiner:	Schwadron, R.

For: **Autogenous Lymphatic Factor for Modification of T and B Lymphocyte Parameters**

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
Mail Stop AF
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

1. This is an appeal from the final rejection of Claims 49-64 and 67-70, all of the pending claims, under 35 U.S.C. §§ 102(a) and 103(a).

2. The rejections are based on the Griffiths primary reference, *i.e.*, one of the two co-inventors, Bertie B. Griffiths, personally gave a presentation entitled "Prospective Substitution of Transfer Factor with In Vitro Stimulated T Lymphocytes" at the Twelfth Annual International Symposium on Man and His Environment in Health and Disease, February 24-27, 1994. The published abstract of this presentation was:

> The phagocytic killing cascades of 70 environmentally sensitive patients with recurrent infections were investigated. These patients presented multiple manifestations to chemicals, food, inhalants, and recurrent infections. Of these, 88% were found with dysfunctions. Treatment, especially with transfer factor and autogenous vaccines, showed significant improvement in total T cells and phagocytic killing.

3. The gravamen of the appeal is whether the Rule 132 attribution declaration by William J. Rea and Bertie B. Griffiths, all the named inventors, removed the "Griffiths

reference" as a primary reference. If so, then the claims are allowable because the secondary references do not show all the elements of the claims.

4. An applicant's own work, even though publicly disclosed prior to his application, may not be used against him as a reference, absent the existence of a time bar to his application. *In re Katz*, 678 F.2d 450, 215 USPQ 14 (CCPA 1981); *In re DeBaun*, 687 F.2d 459, 214 USPQ 933, 935 (CCPA 1982). *See also* 1 *Chisum on Patents* § 3.08[2][a] (2008) (in determining whether prior work is in fact by "another," the theory of the inventorship entity must be applied; the inventive entity is different if not all inventors are the same).

5. Applicants Rea and Griffiths (all the named inventors) filed a declaration under 37 CFR 1.132 in which they declared that:

> "3. I believe the inventors named below to be the original and first inventors of the subject matter which is claimed and for which a patent is sought on currently pending Claim 49 and the other pending claims in the above-identified application for patent.
>
> 4. I declare that each of William J. Rea and Bertie B. Griffiths made a substantial contribution to the conception and substance of th[e] [1994] presentation ... [and] collaborated in the preparation of this presentation. ... I declare that the 1994 presentation is the work of the inventors named in this application for patent." (Emphasis added).
>
> *See also* Applicants' original oath or declaration of inventorship in this application.

6. Authorship of an article by itself does not raise a presumption of inventorship. MPEP § 716.10. See *In re Katz*, 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982) (inquiry is appropriate to clarify any ambiguity created by an article regarding inventorship). "An uncontradicted 'unequivocal statement' from the applicant regarding the subject matter disclosed in an article, patent, or published application will be accepted as establishing inventorship." MPEP § 716.10; *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982). *Compare Ex parte Kroger*, 219 USPQ 370 (Bd. Pat. App. 1982) (Knaster, one of the authors of the reference publication, refused to sign a § 1.132 declaration attributing the invention to Kroger and also submitted a letter claiming to be a coinventor).

7. Here, Applicants' statement is "unequivocal," and there is no evidence to the contrary. MPEP § 716.10. But the Examiner held Applicants' declaration insufficient for the following reasons:

> "Regarding the Rea/Griffith Katz type declaration under 37 CFR 1.132, said declaration is not applicable to the instant rejection wherein the prior art has a single author and there is no indication that the other Inventor (Rea) contributed to claimed subject matter not disclosed in the instant reference. In re Katz, 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982) deals with a scenario wherein additional authors of reference are 'removed' in view of a declaration by Katz that he alone invented the claimed subject matter."

See July 7, 2009 Final Office Action, ¶ 3.

8. The Examiner cites no authority that "attribution" is somehow limited to the situation where "additional authors of [a] reference are '***removed***'" in view of a § 1.132 declaration; or that *Katz* is inapplicable where "the prior art has a single author and there is no indication that the other inventor (Rea) contributed to claimed subject matter ***not disclosed in the instant reference***." (Emphasis added). The Examiner also fails to explain how subject matter not disclosed in the reference relates to the anticipation rejection at issue (and obviousness).

9. The Examiner's position is also contrary to cases wherein the reference article (or U.S. patent) named less than all the applicants for patent, and applicants successfully overcame the reference based on a § 1.132 affidavit. For example, in *In re Manger*, 133 USPQ 404 (1961), three of the four applicants had published an article disclosing their invention less than a year prior to the application's filing date; the three coauthors and coinventors filed an affidavit declaring that the fourth applicant was also a coinventor. The Board refused to sustain the examiner's rejection, stating: "There is no reason to doubt the statement of the three joint inventors as to the participation of the fourth inventor as this statement is of no benefit to them." 133 USPQ at 405.

10. In *Ex parte Cloke*, Appeal No. 2000-0379 (Bd. Pat. Apps. & Interfs. March 13, 2002) (unpub.), the sole applicant was not named as a coinventor in the reference patent; the Board rejected the examiner's position that there must be overlapping inventors before a 37 CFR § 1.132 declaration can be filed. In *Ex parte Synopsis, Inc.*, Appeal No. 2005-2512 (Bd. Pat.

Apps. & Interfs. July 26, 2006) (unpub.), one of the references (the "RailMill documents") had named no authors; the Board held that applicant's declaration was sufficient to remove the RailMill documents as prior art.

11. It is believed that the pending claims are in condition for allowance, and such action is respectfully requested.

12. Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, other distinctions from the cited references may exist, and Applicants reserve the right to discuss any such additional distinctions in a later prosecution response, or in any reissue or reexamination, or in litigation, if appropriate.

13. If a telephone interview would expedite the prosecution of this application, the undersigned can be reached at the telephone number below.

Dated: September 4, 2009

CERTIFICATE OF SERVICE

I hereby certify that this correspondence is being transmitted electronically to the U.S. Patent and Trademark Office MAIL STOP AF, COMMISSIONER OF PATENTS, P. O. BOX 1450, ALEXANDRIA, VA 22313-1450 on:

September 4, 2009
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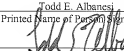
Signature

September 4, 2009
Date of Signature

Respectfully submitted,

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